

Remarks

This application has been carefully reviewed in light of the Office Action mailed March 23, 2005. At the time of the Office Action, claims 1-41 were pending in this application. In the Office Action, the Examiner rejects claims 1-41. Applicants respectfully request reconsideration of the above application in view of the following remarks.

Rejection of Claims 1, 4, 5, 8, 14-18, 20, 29, 30, 31, 33 and 34 Under 35 U.S.C. § 103(a) as Being Unpatentable Over Bezos

Claims 1, 4, 5, 8, 14-18, 20, 29, 30, 31, 33, and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,029,141 (*Bezos*). Applicants respectfully request reconsideration of this rejection because of (1) lack of motivation and (2) *Bezos* fails to teach, suggest or disclose various aspects of the rejected claims.

The Examiner must show a motivation to modify *Bezos* to provide the claimed invention. *In re Rouffet*, 47 USPQ 2d, 1453, 1456 (Fed. Cir. 1998). The motivation requirement prevents impermissible hindsight reconstruction. *Id.* Mere conclusory statements supporting the proposed modification, standing alone, are not “evidence” of motivation. *McElmurry v. Arkansas Power & Light Co.*, 27 USPQ 2d, 1129, 1131 (Fed. Cir. 1993). Moreover, an examiner cannot base an obviousness rejection on opinion alone:

... the Patent Office . . . may not, without some basis in logic or scientific principle, merely allege that such differences are either obvious or of no patentable significance and thereby force an appellant to prove conclusively that it is wrong.

In re Soli, 137 USPQ 797, 801 (CCPA 1963).

The Examiner admits that *Bezos* does not specifically disclose a manufactured product. (Office Action, 03/23/05, p. 3.) The Examiner states that *Bezos* discloses a system where customers order products from a web-site as disclosed in the Abstract. *Id.* The Examiner opines that it would have been obvious to one of ordinary skill in the art to

manufacture a product with the motivation of effectively producing something useful and marketable. *Id.*

The Examiner has not provided the requisite motivation for modifying *Bezos'* web-based system of ordering books to include manufactured products as claimed. The Examiner opines that the motivation is “producing something useful and marketable,” and therefore, it would be obvious “to manufacture a product”. Assuming that the Examiner’s motivation is sufficient, the “to manufacture a product” step is not recited in any of the claims. For example, claim 1 recites “at least one presentation application operable to capture user online session data including … manufactured product configurations”. Claim 1 also recites “[a] report processor … operable to generate a report related to manufactured product online orders”. The Examiner’s cited motivation is not tied to the claimed invention, and is therefore improper. For at least this reason, Applicants respectfully request the Examiner to withdraw this rejection.

Further, the *Bezos* reference combined with the knowledge of one skilled in the art does not teach, disclose, or suggest the claimed invention. According to well-settled law, to establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). In doing so, “all words in a claim must be considered in judging the patentability of the claim against the prior art.” *In re Wilson*, 165 USPQ 494, 496, (CCPA 1970). Claim 1 recites “online session data including … manufactured product configurations”. *Bezos* provides a web-based system for ordering books. Books are not manufactured products. Moreover, books cannot be configured. To the contrary, each book has its own unique identifier, referred to as an ISBN. The Examiner relies on the knowledge of one skilled in the art for teaching the elements missing from the *Bezos* reference. The Examiner’s reliance is misplaced because (1) the required motivation to combine has not been shown and (2) the knowledge being relied upon is deficient. With respect to the first point, the identified motivation of “producing something useful and marketable” is deficient for the above-identified reasons. With respect to the second point, the Examiner states that it would be obvious “to manufacture a product”. Assuming this

statement is supported by the knowledge of one skilled in the art, it does render the claimed invention obvious. Claim 1 recites “manufactured product configurations” and “manufactured product online orders” (independent claims 14 and 29 have analogous limitations) – limitations not addressed by the Examiner’s obviousness analysis.

For at least these reason, claims 1, 14 and 29 are patentable in light of the *Bezos* reference and the other art of record. Further, claims 4, 5 and 8 (depending from claim 1); claims 15-18 and 20 (depending from claim 14); and claim 30, 31, 33 and 34 (depending from claim 29) are patentable for at least the same reasons, as well as their own patentable limitations.

**Rejection of Claims 3, 19 and 32 Under 35 U.S.C. § 103(a)
As Being Unpatentable Over Bezos in Further View of Cathey**

Claims 3, 19 and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bezos* and in further view of U.S. Patent No. 6,029,141 (*Cathey*). Applicants respectfully traverse this rejection.

Claims 3 depends from claim 1, which Applicants have shown above to be allowable, and are allowable for at least this reason. In addition, claim 3 recites further patentable distinctions over the art of record. Claims 19 depends from claim 14, which Applicants have shown above to be allowable, and are allowable for at least this reason. In addition, claim 14 recites further patentable distinctions over the art of record. Claims 32 depends from claim 29, which Applicants have shown above to be allowable, and are allowable for at least this reason. In addition, claim 32 recites further patentable distinctions over the art of record. However, to avoid burdening the record and in view of the clear allowability of independent claims 1, 14 and 29, Applicants do not specifically address these reasons in this response. Applicants reserve the right to present these reasons in a future response if appropriate.

***Rejection of Claims 2, 6, 7, 9, 10, 22, 23, 27, 28,
36, 37, 40, and 41 Under 35 U.S.C. § 103(a) as
Being Unpatentable Over Bezos in Further View of Brandt***

Claims 2, 6, 7, 9, 10, 22, 23, 27, 28, 36, 37, 40, and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bezos* and in further view of U.S. Patent No. 6,377,993 (*Brandt*). Applicants respectfully traverse this rejection.

Claims 2, 6, 7, 9 and 10 depend from claim 1, which Applicants have shown above to be allowable, and are allowable for at least this reason. In addition, claims 2, 6, 7, 9 and 10 recite further patentable distinctions over the references of record. Claims 22, 23, 27 and 28 depend from claim 14, which Applicants have shown above to be allowable, and are allowable for at least this reason. In addition, claims 22, 23, 27 and 28 recite further patentable distinctions over the references of record. Claims 36, 37, 40 and 41 depend from claim 29, which Applicants have shown above to be allowable, and are allowable for at least this reason. In addition, claims 36, 37, 40 and 41 recite further patentable distinctions over the references of record. However, to avoid burdening the record and in view of the clear allowability of independent claims 1, 14 and 29, Applicants do not specifically address these reasons in this response. Applicants reserve the right to present these reasons in a future response if appropriate.

***Rejection of Claims 11, 26, and 39 Under 35 U.S.C. § 103(a)
As Being Unpatentable Over Bezos in Further View of Sutcliffe***

Claims 11, 26, and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bezos* and in further view of U.S. Patent No. 6,073,105 (*Sutcliffe*). Applicants respectfully traverse this rejection.

Claims 11 depends from claim 1, which Applicants have shown above to be allowable, and are allowable for at least this reason. In addition, claim 11 recites further patentable distinctions over the art of record. Claims 26 depends from claim 14, which Applicants have shown above to be allowable, and are allowable for at least this reason. In

addition, claim 14 recites further patentable distinctions over the art of record. Claims 39 depends from claim 29, which Applicants have shown above to be allowable, and are allowable for at least this reason. In addition, claim 39 recites further patentable distinctions over the art of record. However, to avoid burdening the record and in view of the clear allowability of independent claims 1, 14 and 29, Applicants do not specifically address these reasons in this response. Applicants reserve the right to present these reasons in a future response if appropriate.

Rejection of Claims 12, 13, 21, 24, 25, 35 and 38 Under 35 U.S.C. § 103(a) as Being Unpatentable Over Cathey in Further View of Brown

Claims 12, 13, 21, 24, 25, 35, and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,778,182 (*Cathey*) and in further view of U.S. Patent No. 5,794,219 (*Brown*). Applicants note that the Examiner cites to the *Bezos* reference in the discussion supporting this rejection. Applicant assumes that the Examiner mistakenly referred to *Cathey* in the rejection heading, instead of *Bezos*. Applicants will treat this rejection as if it were based on the combination of the *Bezos* and *Brown* references. Applicants traverse this rejection.

Claims 12 and 13 depend from claim 1, which Applicants have shown above to be allowable, and are allowable for at least this reason. In addition, claims 12 and 13 recite further patentable distinctions over the references of record.

For example, claim 13 recites “wherein the manufactured products are automobiles”. The Examiner admits that this limitation is not taught, disclosed or suggested by the *Bezos* reference. However, the Examiner opines that the *Brown* reference provides this limitation. The Examiner cites to the following passage of *Brown*:

Another use of television to sell items is described in an article entitled “Auctions Become High Tech”, Dealer Business, Mar. 1995 V29 N7. The article describes an auction system in which an auction company sends a signal via satellite to the televisions of individual car dealers. The dealers view the car for sale on their televisions and bid on the car using a telephone or a remote

terminal. Like the previous on-line auction systems, this system offers no mechanism for dealers to pool their bids. Individual bidders must still cover the entire cost of items purchased.

(col. 2, ll. 34-36.)

The Examiner opines that it would have been obvious to one of ordinary skill in the art at the time of the Applicants' invention for the products to be automotive vehicle with the motivation of incorporating the automotive industry that dealers participate in into [sic] an on-line purchasing process. (Office Action, 03/23/05, pp. 12 and 13.)

Applicants note that the Examiner is incorrectly relying on the *Brown* reference. The cited passage of *Brown* summarizes an article entitled "Auctions Become High Tech" and authored by Maynard Gordon ("the *Gordon* publication"). Applicants respectfully submit an Information Disclosure Statement citing to this publication.

The proposed *Bezos-Gordon* combination does not teach, disclose or suggest the invention as recited in claim 13. For instance, claim 13 requires the capture of "manufactured product configurations" for "automotive vehicles". The Examiner admits that the *Bezos* reference does not teach, disclose or suggest this limitation. Moreover, the *Gordon* publication does not cure the defective teachings of *Bezos*. *Gordon* is directed at "auto auctions". According to one auction system, the "operation sends an auction signal via fiber optic cable ... to ... headquarters ... , the signal is transmitted via satellite to ... dealers." According to another auction system, "Mitsubishi dealers, sitting in their own offices, bid on vehicles with the touch of a button or a specially designed bidding stick." Neither system provides the claimed "online system for generating reports related to manufacturers consumer product online orders" based on "manufactured [vehicle] product configurations". The *Gordon* systems do not teach, disclose or suggest "product configurations". To the contrary, the *Gordon* systems provide for the auction of "as-is" vehicles. In other words, a pre-ordained vehicle is offered for auction, and interested buyers can make bids using, for example "a button" or "bidding stick". For at least this reason, claim 13 is patentable over the art of record.

Claims 21, 24 and 25 depend from claim 14, which Applicants have shown above to be allowable, and are allowable for at least this reason. In addition, claims 21, 24 and 25 recite further patentable distinctions over the references of record. Claims 35 and 38 depend from claim 29, which Applicants have shown above to be allowable, and are allowable for at least this reason. In addition, claims 35 and 38 recite further patentable distinctions over the references of record. However, to avoid burdening the record and in view of the clear allowability of independent claims 1, 14 and 29, Applicants do not specifically address these reasons in this response. Applicants reserve the right to present these reasons in a future response if appropriate.

Conclusion

For the foregoing reasons, Applicants believe that the Office Action of March 23, 2005 has been fully responded to. Consequently, in view of the above amendments and remarks, Applicants respectfully submit that the application is in condition for allowance, which allowance is respectfully requested.

No additional fee is believed to be due as the result of the filing of this paper. However, any additional fees or credits should be applied to Deposit Account 06-1510 (Ford Global Technologies, Inc.). A duplicate of this paper is enclosed for that purpose.

If the Examiner feels that a telephone conference would advance prosecution of this application in any manner, the Examiner is invited to contact Matthew M. Jakubowski, attorney for Applicants, at the Examiner's convenience at (248) 358-4400.

Respectfully submitted,

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Date: June 23, 2005

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